UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/037,271 | 11/07/2001 | Scott W. Huffer | 9325-58 (153520) | 7750 |

7590 09/02/2003

Drinker Biddle & Reath LLP
18th and Cherry Streets
One Logan Square
Philadelphia, PA 19103-6996

| EXAMINER |
|---|
| YAN, REN LUO |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2854 | |

DATE MAILED: 09/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 10/037,271 | Applicant(s) HUFFER, SCOTT W. | |
|---|---|---|---|
| | Examiner Ren L Yan | Art Unit 2854 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *07 November 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☐ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) *15-19* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☒ Claim(s) *14* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-14, drawn to a printing process, classified in class 101, subclass 483.

II. Claims 15-19, drawn to a printed product, classified in class 428, subclass 195.

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the printed product can be made by providing step c) prior to step b) and also curing may be done by using an oven.

During a telephone conversation with Mr. Steve Nash on 5/1/03 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-19 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim 14 is objected because it apparently depends upon a wrong product claim 17. Correction is required.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 and 10-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,546,872 in view of Kawahata et al(5,019,202). Claims 1-11 of the '872 patent teaches all that is claimed in a printing process except for the use of electron beam process to cure the coating. Kawahata et al teaches in a similar printing process the conventional use of electron beam process to cure a coating. See the paragraph bridging columns 11 and 12 in Kawahata et al for example. It would have been obvious to those having ordinary skill in the art to provide the printing process in the '872 patent with the electron beam process as taught by Kawahata et al in order to more effectively cure the coating layer so as to obtain a desired appearance of the printed product.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 5-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawahata et al(5,019,202). Kawahata et al. teaches a printing process comprising the steps of providing a printing ink, adding a surface tension lowering additive to the ink, printing the ink

onto a substrate in a pattern, drying the ink, applying a coating over the substrate and the ink, allowing the coating to flow from the ink printed areas to the non-printed areas (which inherently occurs due to the repellency of the coating from the ink areas), and allowing the coating to dry in the form of raised profile ridges. See column 7, lines 18-29 and lines 32-55 in particular. It is noted that the independent claim 1 recites applying a coating on a substrate first and then an ink on top of the coating layer. However, in dependent claims 8 and 9, the coating is defined to be an ink(s). To the extent that the claim language of claims 8 and 9 is clear to convey applicant's intension as to the scope of the claimed invention, the recited coating and ink are meant to be interpreted interchangeably. Accordingly, it would have been obvious to one of ordinary skill in the art that the printing ink of Kawahata et al. can broadly be considered to be the "coating" as recited and the coating of Kawahata et al. can broadly be considered "ink" in the claim language.

With respect to claims 5-6, note column 6, lines 48-68.

With respect to claims 7-9 and 10-13, although Kawahata et al. do not teach the particular coatings or substrate materials set forth in the claims, it would have been obvious to one of ordinary skill in the art to use any desired coating material (metallic, multicolored, etc.) on any desired substrate (i.e., foils, clear films, etc.) to produce any desired coloring or effect, as this would simply involve the obvious selection of known materials based upon their known properties.

With respect to claim 14, note that Kawahata et al. teach that any of a variety of surface tension lowering additives may be added to the ink. See column 6, lines 17-21 of Kawahata et al. In view of these teachings, it would have been obvious to one of ordinary skill in the art to

use any surface tension lowering additive in the ink of Kawahata as it simply requires the obvious selection of a known material based upon its known properties.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawahata et al. (US 5,019,202) as applied to claim 1 above, and further in view of Sato et al. (US 5,665,457). Kawahata et al. teaches a printing process as recited with the possible exception of the ink being printed in a pattern of parallel lines. However, note that the selection of the particular pattern of the ink appears to involve simply an obvious matter of design choice. Furthermore, although Kawahata et al. is silent with respect to the particular pattern the ink is printed in, Sato et al. teach a printing process including printing an ink in a pattern of substantially parallel lines as shown in the Figure. In view of this teaching, it would have been obvious to one of ordinary skill in the art to print the ink pattern of Kawahata et al. in any desired pattern, such as a pattern of substantially parallel lines, as it involves design choice and simply requires the obvious substitution of one known pattern for another.

With respect to claims 3-4, note Sato et al. teach non-printed areas being arranged between the ink pattern and both Kawahata and Sato teach the coating forms raised ridges oriented along the printed ink pattern. See, for example, column 9, lines 3-14 in Kawahata et al. and column 3, lines 20-30 of Sato et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ren L Yan whose telephone number is 703-308-0978. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 703-305-6619. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Ren L Yan
Primary Examiner
Art Unit 2854

Ren Yan
Aug. 22, 2003